Remarks

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RE:	Patent Application for Bullock	Date:	Sept. 30, 2004
Serial No.:	09/886,937	Art Unit:	1638
Filed:	6/21/2001	Examiner:	Helmer, Georgia
For:	Shaken Not Stirred	Action:	Office action Response

To: The Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Remarks

In paragraphs 1-4, the Examiner indicated that the claims 7-20 are subject to being withdrawn. The applicant's attorney has withdraen claims 7-20.
The Examiner objectd to the specification line 17-20 of page 3 indicating that the PCT listed was not supplied in an IDS. The Examiner has been supplied with this PCT application by Fax earlier. Thus this PCT is now part of the IDS and should be considered in review of this application.

In paragraph 6 the Examiner indicates that claim 2 is objected to under 37 CFR 1.75© as being in improper form. Claim 2 has been amended to depend from claim 1. The Examiner is kindly requested to remove the objection.

In paragraph 7-8 the Examiner rejected claim 3 for lack of antecedent basis. This claim has been amended.

In paragraphs 9-10 claims 1-6 were rejected under 35 UCS §112, first paragraph, as not complying with the enabling requirement. The claims are supposedly not described in the specification in such a way as to enable a person skilled in the art to make and/or use the invention. The applicant has amended the claim to reflect the range of cycles that are involved in this shaking motion. Additionally,

the applicant has in claim one clarified the improvement and in claim 6 has specified the shaking mechanism.

The Examiner is indicating that the breathe of the claims are too broad. The claims are now amended to reflect a narrower scope. The Applicant would like to indicate that the amended claims are fully enabled. The applicant also notes there is no lack of guidance nor is there unpredictability in using the claimed method. The factors in *Wands* are not being applied in a correct manner by the office. The MPEP states at 2164 that,

> Supreme Court decision of *Mineral Separation v. Hyde,* 242 U.S. 261, 270 (1916) which postured the question: **is the experimentation needed to practice the invention undue or unreasonable?** (emphasis added)). That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.,* 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). **A patent need not teach, and preferably omits, what is well known in the art.** (emphasis added). *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984

The patent office has already allowed claims to the method of Whiskering in US. Patent. These claims are by statute presumed valid. Whiskering is not an unpredictable method of transforming. And according to the MPEP and the Federal Circuit '**A patent need not teach, and preferably omits, what is well known in the art**' There are, as is evidenced in the IDS articles and patents,

and in US patents 5,464,765, 5,302,523, 6,730.824, etc. numerous examples of transformation with whiskers of all kinds of plants, target tissues, genes and the like. It has been employed in cotton, rice, corn, grass, canola, sugar beets, etc. The steps to perform whiskering are known and are also clearly displayed in this specification. Whiskering is not unpredictable. It is, however, not as efficient as some other transformation methods. Lack of efficiency does not mean unpredictable, nor does it mean that the experimentation is undue.
The MPEP states

> The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd. sub nom., Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). See also *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

Whiskers have been employed in numerous applications this application does not have to provide any more guidance on the Whiskering method. A specification is not a textbook for doing everything that anyone has ever published and it should not attempt to be a textbook. The invention specifies making the cocktail using whiskers and the improvement of having this shaking motion at certain cycles. It does not take undue experimentation to take the cocktail, add the whiskers and shake.

The specification only needs to meet the requirements of describing an invention in a manner to enable any person skilled in the art to make and use the same. This application does just that very thing. What must be described is the invention of the method. This invention is not 'whiskering' that is a known and patented and well-published method. This invention is "whiskering" with the step of using the shaking motion, which is described and fully exemplified in the specification.

If a method of using a new type of nail to hold two piece together was to be patented the Examiner would not require the method to include what type of wood the two pieces were, what possible hammer head would be used, what pound force of pressure would be used. The patent office in the biotech division seems to have its own enablement section which includes everything as undue experimentation. Either the ordinarily skilled biotech person is incompetent or in all the other divisions of the patent office the ordinarily skilled person is a super hero of knowledge. The biotech person like other ordinarily skilled persons is aware of the various target tissues, protocols, the teaching of transformation methods ie the prior art. And as the caselaw teaches us,

A patent need not teach, and preferably omits, what is well known in the art. (emphasis added). *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984)

And the fact that the ordinarily skilled person can transform with Whiskers is known, what the specification adds is a step that increases the efficiency of the transformation process. Thus the method including the step of shaking are all well described such that the ordinarily skilled person can do the method as claimed without undue experimentation. The applicant requests that the Examiner remove the rejection to the claims.

The applicant believes that the 102 (b) rejection under Coffee, to claims 1-6 should be overcome, in light of the amendment to the claim one to reflect that range of the cycle and in claim 6 to the shaking mechanism. Coffee does not teach this shaking motion as claimed in either claims 1 or 6 with the amended language on the shaking mechanism and the cycles. The applicant also believes that these two amendments should overcome the finger tapping that is shown in Frame. The applicant requests that both of the §102 (b) rejections be removed.

The applicant's attorney respectfully submits that the office action amendment places the application in position for allowance and requests action to that effect.

Respectfully submitted,

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